



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,310	12/01/2003	Satoshi Okano	KON-1837	2916

20311 7590 06/21/2006

LUCAS & MERCANTI, LLP
475 PARK AVENUE SOUTH
15TH FLOOR
NEW YORK, NY 10016

EXAMINER

LE, HOA VAN

ART UNIT PAPER NUMBER

1752

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/725,310

Applicant(s)

OKANO ET AL.

Examiner

Hoa V. Le

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 and 30 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-9,12 and 14 is/are pending in the application.
- 4a) Of the above claim(s) 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-9 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

This is in response to Papers filed on 25 and 30 May 2006.

I. The elected invention of claims 1, 5-9 and 14 are rejected under 35 U.S.C.103(a) as being unpatentable over Kuykendall et al (6,534,253) considered in view of Kamada et al (5,534,395).

Kuykendall et al disclose, teach and suggest a (combined function) bleach-fixing composition having a pH solution of from 4 to 10 and comprising up to 3 mol/l and up to 100 mol% of a silver ion bleachable (oxidizer-able) agent being ferrous (Fe^{2+}), salt of an aminopolycarboxylic acid and up to 5 mol/l of a thiosulfate as a fixing (silver halide solvent) agent and conventional additives. Please see the whole disclosure of each of the applied references, especially in Kuykendall et al at col.10:56-67, 4:50-52, 5:43-44, 7:23-25 and 39-64, 8:9-31, Table 1.

Kuykendall et al disclose, teach and suggest the conventionally bleach-fixing additives but do not specify imidazole containing compounds in the general formula (1). However, Kamada et al at col.3:6-15 and discloses, teaches and suggests the use of from 0.02 to 2 mol/l of imidazole containing compounds in a bleach-fixing composition for the advantage of a whiteness improvement in a rapid

Art Unit: 1752

process using a reduced amount of a bleach-fixing replenisher Table 13 and col.69:23-27.

Since the above references are all related to silver halide color photographic materials and their desilvering processes using the combined function bleach-fixing compositions to obtain stable color images, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite imidazole containing compound from Kamada et al for a reasonable expectation of obtaining a whiteness improvement in a rapid process using a reduced amount of a bleach-fixing replenisher as disclosed, taught, suggested and obtained in Kamada et al.

II. Applicant's arguments filed 25 and 30 May 2006 have been fully considered but they are not persuasive.

(i) Applicants urge that the claims are allowable and patentable for whiteness improvement (stain reduction) from three to eight times with the use of from an amount of 0.1 to 2.5 mol/l of an imidazole containing compound. However, the showings are limited. An allowed claim or a patent would have no value, when someone later show that one combination of the chemical composition as broadly disclosed in the claim does not provide (*) up to three times or more of

Art Unit: 1752

whiteness improvement, (**) about or obviously the same in whiteness improvement as that in the applied Kamada et al (5,534,395) and (***) about or obviously the same bleach fixing power as that in the applied Kuykendall et al (6,534,253).

(ii) Applicants rely on the showings under Rule 132 for the patentability of the claims. They have been carefully considered in the next paragraph.

III. Applicants' declarations under Rule 132 filed on 20 July 2005 and 24 January 2006 have been fully considered but is insufficient to overcome the applied references of the record. The evidence is not commensurate in scope with the claims (Please see MPEP 716.02(d)).

(1) There is no creditable patentability for the instantly claimed concentrate bleach fixing composition precursor as broadly claimed with up to 100 mol/% of ferrous (Fe^{+2}).

(a) The tests are on the bleach fixing composition from its precursor that has gone through a process of oxidizing ferrous (Fe^{+2}) from 100 mol/% down to 50 mol/% and converted to 50 mol/% of ferric (Fe^{+3}) to have a sufficient oxidizing power to oxidize silver ions on an exposed silver halide photographic material. Otherwise, the precursor is useless because it cannot

and insufficient to oxidize and remove silver ions from an exposed silver halide photographic material. Applicants should provide an evidence to the contrary.

(b) The tested results are collected on the directed use of the bleach fixing composition but not its remote precursor. Applicants should provide an evidence to the contrary.

© The whiteness improvement (stain reduction) results from the use of an imidazole are on the process of use only but not from a directed use of a bleach fixing composition, per se, or its remote precursor, per se.

Accordingly, the showings would be give a full creditable patentability to a process of using claim. However, However, it is not new or novel since it has been disclosed, taught, suggested, demonstrated, reduced to practice and obtained on in the applied Kamada et al (5,534,395) on the record.

(d) There is no unusual or unexpected result for a patentability of the instantly claimed bleach fixing composition precursor, per se, such as precipitation, stability...

(2) The showings with respect to whiteness and stain reduction are not disclosed, taught or suggested in the primary reference with respect Kuykendall et al (6,534,253). But they are disclosed, taught, suggested, obtained, demonstrated

Art Unit: 1752

and reduced to practice in the applied secondary reference with respect to Kamada et al (5,534,395) as clearly pointed out and set forth on the record. Repeats of same or about the same finding whiteness and stain reductions as disclosed, taught, suggest, obtained, demonstrated and reduced to practice from one of the applied set of the references are not new, novel or unexpected feature for a patentability of the claims. It may be a routine practice for an optimum result of a known property of the known chemical ingredient (imidazole compound in a known bleach-fixing composition).

(3) The tests are mostly limited use the chemical composition in Table V in Kuykendall et al for the patentability of the claims. Since the patentability of the claims is based on the limited showing of the chemical composition In Table V in Kuykendall et al, no patentable value would be considered or given beyond the tested chemical composition (with respect to the reasonable in the art of (i) the same chemical and adjacent homologous compound(s) and (ii) about the same amount (with + and – about 0.01%) and procedure as tested.

(4) The instant claims have not been reasonably limited to the use of about 113.75 g/l of ethylenediaminetetraacetic acid and about 101.88 g/l of ferrous sulfate heptahydrate (20%) and about 226 g/l of ammonium sulfate as tested.

(5) The tests use the bleach fixing composition precursor in Table V with

Art Unit: 1752

100 mol% of ferrous (Fe^{+2}) in Kuykendall et al for the patentability of the claims is improper because it is not shown to be able to effectively oxidized silver ions from an exposed silver halide photographic material for sufficient silver removal since the tested chemical composition is a bleach fixing precursor only. Applicants should show or provide a convincing evidence to the contrary for the record and for the patentability of the claims.

(6) The showings use an oxidization to 50 mol/% of ferrous (Fe^{+2}) but not up to 100 mol/% of ferrous (Fe^{+2}) as broadly claimed.

For the above reasons the showings are incomplete, improper and much broader than those in the claims.

Applicants continuously fail the showings to the broad limitations of the claims as clearly pointed out and set forth on the record.

It would like to see tested results to be carry out with mixing of (*) about 0.5 to 4 mol/l of a fixing agent as disclosed on page 40, (**) about 0.036 and 0.252 mol/l of ferric salt of an aminopolycarboxylic acid (bleaching or oxidizing agent) on page 69, (***) about 0.18 and 0.288 mol/l ferrous salt of an aminopolycarboxylic acid (bleach or oxidizing precursor) on page 69, (****) about 0.01 to 2.5 mol/l of an imidazole compound on page 14 and (*****) a ratio of iron ions to aminopolycarboxylic ions being about 1.01 to 1.00 on page 12 of the

Art Unit: 1752

instant application of whiteness and stain reduction tests. The instant claims should be limited to the tested chemical ingredients and their adjacent homologue and about their amounts (with + and - of 0.01%) as tested to be reasonable commensurate in scope with the broadly claimed precursor in the next response to this Office action in order for it to be considered timely. It is again clearly pointed out, notified and set forth the record.

V. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR

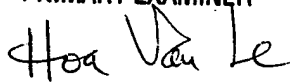
Art Unit: 1752

or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
13 June 2006

HOA VAN LE
PRIMARY EXAMINER

A handwritten signature in black ink that reads "Hoa Van Le". The signature is written in a cursive, flowing style.